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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,816	09/30/2003	Johann J. Neisz	AMS-029B	6669

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

GILBERT, SAMUEL G

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 06/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/675,816

Applicant(s)

NEISZ ET AL.

Examiner

Samuel G. Gilbert

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 36-39, 42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 11-14, 36, 38, 39, 42 and 43 is/are rejected.
- 7) ☒ Claim(s) 5 and 10 is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. .
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u> </u> |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/4/05</u> , plus 1 photocopy 2016 transcription | 6) <input type="checkbox"/> Other: <u> </u> |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed 11/26/2004 has been considered. References identified as AA, AB, AC, and AF have not been considered because they were considered in the information disclosure statement considered by the examiner on 11/26/2004. The examiner has also included an initialed copy of page 2 of 16 from the IDS considered by the examiner on 11/26/2004 because initials were not included at that time.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the structure required to perform the recited function, claim 43, has not been linked or associated with that function in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 6-9, 12, 13, 36, 42, and 43 are rejected under 35 U.S.C. 102(b) as being anticipated by Sohn et al (WO 97/47246).

Claims 1 and 2 - Sohn et al teaches an implantable material, sling material page 8 line 26; a first type of needle element -140- a straight needle; and a second type of needle, element -132- curved needle. The examiner is taking element -22- a thread, operatively connected to the needle to be an adapter for associating the implantable material with one of the needles.

Claim 6 - the examiner is taking the insertion guns as handles, Sohn et al sets forth at least three different types of guns -30-, -41- and -90-.

Claims 7-9 - needle -140- can be a suture passer -150- including an eye -158- and a sheath -154-.

Claim 12 - the examiner is taking the insertion guns as handles, Sohn et al sets forth at least three different types of guns -30-, -41- and -90-.

Claim 13 - the curved needle -132- is longer than straight needle -140-.

Claim 36 - the use of the apparatus set forth by Sohn et al would inherently use the method as claimed. The examiner is taking element -22- a thread, operatively connected to the needle to be an adapter for associating the implantable material with one of the needles. The only positively recited step involving the adapter is providing the adapter. Sohn et al clearly provides the threads -22-.

Claim 42 - Sohn et al teaches an implantable material, sling material page 8 line 26; a first type of needle element -140- a straight needle; a second type of needle, element -132- curved needle and the examiner is taking insertion guns as handles, Sohn et al sets forth at least three different types of guns -30-, -41- and -90-. The examiner is taking element -22- a thread, operatively connected to the needle to be an adapter for associating the implantable material with one of the needles.

Claim 43 - Sohn et al teaches an implantable material, sling material page 8 line 26; a first type of needle element -140- a straight needle; and a second type of needle, element -132- curved needle. The needles and sutures of Sohn et al teach means for transporting the sling material in a body. The examiner does not consider the claim to invoke 112 6th paragraph because the "means for" language is modified with sufficient structure, "needle" for achieving the specified function. It is the examiners position that the needles are all or a sufficient part of the structure required for transporting the sling material and the sling cannot be transported without the needle..

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sohn et al. (WO 97/47246) in view of Berger (2002/0091373). Sohn teaches a kit as

claimed but does not teach a sheath a sheath associated with the sling. Berger teaches a sling -64- that includes a sheath -66-. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a sheath as taught by Berger with the sling of Sohn to prevent the sling of Sohn from prematurely adhering to the tissue while being implanted as taught by Berger, paragraph [0038]. The sutures of Sohn prove an adapter for associating the sling and the surgical needle.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sohn (WO 97/47246) in view of Cook(cited by the applicant). Sohn teaches the use of two needles one curved and one being straight. The shapes of the needles are determined by the intended use, (the desired path of the needles to properly locate the suture anchor point from the needle insertion point. The selection of any particular shape for the needles used would allow the medical practitioner to use any desired needle path to delivery the sutures. EPO 0,470,308 Lemay teaches the use of shapeable needles to provide the medical practitioner the most flexible range of needle paths. Cook page 9 teaches Stamey needles having a straight configuration a 15 degrees angle and a 30 degree angle configuration. It is the examiner's position that the selection of any particular angled configuration would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the practitioner to use a variety of different needle paths to properly insert the anchor suture of Sohn.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sohn (WO 97/47246) in view of Allosling Fascia, 1999.

Sohn teaches a device as claimed including a needle(suture passer as described above) but does not teach a bladder perforation detector. Allosling teaches a suture passer for incontinence surgery including a leak detection sheath for detecting if the bladder has been perforated. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the detection means as taught by Allosling with the suture passer taught by Sohn to provide the advantage of having a suture passer that will allow the user to determine if the bladder has been perforated without withdrawing the suture passer and inserting a separate detection device.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 38 and 39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 62 of copending Application No. 10/005,837. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are obvious changes in the scope of the claims

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claims 5 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 37 is allowed.

Response to Arguments

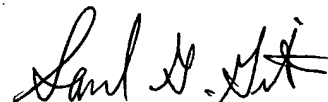
Applicant's arguments with respect to claims 1-4,6-9, 11-14, 36, and 42 and have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Samuel G Gilbert
Primary Examiner
Art Unit 3736

sgg